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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,597	03/26/2001	Motoki Nakade	450100-03084	7826
20999	7590	02/10/2004	EXAMINER	
FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151			BARTUSKA, FRANCIS JOHN	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,597

Applicant(s)

NAKADE ET AL.

Examiner

F. J. BARTUSKA

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1, 3-6, 9-17, 19-22 and 28-30 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Gerszberg et al. Gerszberg et al disclose a videophone system for transmitting audio and video signals wherein a first image signal of a caller is displayed at 160 to a

person being called, the first image is superimposed upon a second image signal that includes advertising at 300a, 300b, 300c and 300d, the first and second image signals are combined to form a third image signal that is displayed to the person receiving the videophone call.

Re claims 5, 6 and 22, Gerszberg et al disclose providing more information about the advertisers in col. 9, lines 35-64.

Re claims 9-11 and 20, Gerszberg et al disclose paying consideration to the person receiving the advertisements in the form of rate discounts in col. 9, lines 26-30.

Re claim 12, Gerszberg et al disclose selective delivery of advertisements in col. 9, lines 30-34.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner

presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al. Gerszberg et al disclose all the features of the applicants' claimed invention except the limitation that the advertiser initiates the videophone call. Merely calling for a marketer to initiate phone calls involves only a notorious expedient to one of ordinary skill in the art.

6. Claims 7, 8, 18 and 31-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al in view of Ebisawa. Gerszberg et al disclose all the features of the applicants' claimed invention except including an image wherein the image of a user of the terminal puts on

the goods being advertised. Ebisawa disclose in Figs 2A and 2B an advertising display wherein the advertisement is superimposed on a person. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Ebisawa to superimpose the advertising display of Gerszberg et al onto the image of the person if goods such as clothing are being advertised.

7. Claims 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gerszberg et al in view of Murray. Gerszberg et al disclose all the features of the applicants' claimed invention except including means for positioning the second image on the first image. Murray shows in Figs. 5a and 5b means for positioning an advertising display 94 on another image to increase the effectiveness of the advertising. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Murray to provide the system of Gerszberg et al with means to position the advertising image on the image of the caller to increase the effectiveness of the advertising.

Specification

8. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors.

Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Japanese publication is cited to show a TV telephone wherein an image is superimposed on another image. Shaw et al is cited to show advertisements that are superimposed on e-mail. Satoh is cited to show another videophone system that superimposes images.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to F. J. BARTUSKA whose telephone number is 703-308-1111. The examiner can normally be reached on MONDAY-FRIDAY (ALTERNATE FRIDAYS OFF).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ROBERT P. OLSZEWSKI can be reached on 703-308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

fjb


F. J. BARTUSKA
PRIMARY EXAMINER 2-304